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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,392	11/12/1999	TAKASHI AOYAMA	2312-105	9249
6449	7590	11/05/2003	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				ZARA, JANE J
ART UNIT		PAPER NUMBER		
		1635		

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

F-24

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/438,392	AOYAMA ET AL.	
	Examiner Jane Zara	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 August 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 67-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 67,70 and 75-78 is/are allowed.
- 6) Claim(s) 68,69,71-74,79-83 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

This Office action is in response to the communications filed August 11, 2003.

### ***Response to Arguments and Amendments***

Applicant's arguments with respect to the 103 rejection of claims 67-75 and 77-83 have been considered and are persuasive. However, the following new ground(s) of rejection are set forth below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 69, 74, 79-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 69, line 1, and claim 81, line 2, the terms "ipt" and "CKI1" are vague and unclear (e.g. replacing the abbreviations with the full names of the genes would perhaps be remedial).

In claims 74 and 83, line 2, the term "LC" is vague and unclear (e.g. replacing the abbreviation with the full name of the gene would perhaps be remedial).

In claim 79, line 1, it is unclear which nucleic acid is being referred to (e.g. replacing "a" with –the—would perhaps be remedial).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 68, 69, 71-74, 80-83 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to compositions comprising genes encoding selectable or screenable markers, members of the knotted family, genes that promote shoot regeneration and development, genes that promote somatic embryogenesis, genes for antibiotic or herbicide resistance, and genes that cause anthocyanin production. The specification and claims do not describe the elements which are essential to the various genera claimed, including essential elements of the various broad genera comprising either screenable markers, members of the knotted family, genes that promote shoot regeneration and development, genes that promote somatic embryogenesis, genes for antibiotic or herbicide resistance, or genes that cause anthocyanin production. The specification and claims do not indicate what distinguishing attributes are concisely shared by the members of the various genera claimed. The scope of the claims

includes numerous structural variants and each genus is highly variant, because a significant number of structural differences between members of a given genus is permitted. Concise structural features that could distinguish structures within a genus from others are missing from the disclosure. The general knowledge and level of skill in the art do not supplement the omitted description because specific, not general, guidance is what is needed. The specification fails to teach or adequately describe a representative number of species in each genus such that the common attributes or characteristics concisely identifying members of each proposed genus are exemplified, and because each genus is highly variant, the description provided is insufficient. One of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe the various genera claimed. Thus, Applicant was not in possession of the claimed genera.

***Allowable Subject Matter***

Claims 67, 70 and 75-78 appear free of the prior art of record.

***Conclusion***

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(703) 306-5820**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (703) 308-0447. Any inquiry regarding this application should be directed to the patent analyst, Katrina Turner, whose telephone number is (703) 305-3413. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



RAM R. SHUKLA, PH.D.  
PRIMARY EXAMINER